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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/924,157 | 08/27/2001 | Arndt Jentzsch | 0828-022 | 1783 |

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06/20/2003

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EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

12

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,157

Applicant(s)

JENTZSCH, ARNDT

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 11 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Applicant is reminded of the proper language and format for an abstract of the disclosure:

The abstract should be in narrative form and limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the "Summary" at the end of the specification should be replaced with an --Abstract-- in accordance with the above suggestions.

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing. (While the priority document DE 100 39 817.0 contains a figure, no drawings have been filed in this application.)

The disclosure is objected to because of the following informalities: On page 1 line 13 "changes" should be --change--, on page 2 line 10 "in traversing imaging unit" should be corrected, and on page 3 line 12 reference numeral "6" should presumably be --5--. (With respect to the figure in the priority document note that there is no reference numeral "2" as indicated on

page 2 line 17+ in the specification and the "arrow" on page 3 lines 15 - 16 in the specification has no reference numeral. Appropriate correction is required.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear from the disclosure how the coating unit (4) and image creating unit (5) are combined into a "single combined unit". See page 3 lines 10 - 11 in the specification and claims 8 and 9, for example. It is not clear if the coating unit and image creating unit are omitted and replaced with, for example, a single ink jet head that jet coats only the image on the printing form or that both the coating unit (4) and image creating unit (5) are ink jet heads in which they are merely attached so as to be a "single combined unit".

Claims 5 - 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5 it is not clear how "each unit" is located one "below the other". For example, the cleaning unit (3) is not "below" another unit. In line 4 it is not clear how the recitation "traversing" limits the scope of the claim. It would appear that the imaging unit is mounted to traverse over the width of the cylinder but the recitation is grammatically awkward.

In claim 6 it is not clear what the recitation "vertically preceding" encompasses. Does it mean that the cleaning unit precedes the coating unit in a direction of rotation of the form

cylinder, the cleaning unit is vertically above the coating unit, or the cleaning unit is vertically below the coating unit.

In claim 8 it is not clear if the recitation of a "single combined unit" improperly modifies the scope of claim 5 by claiming less elements than claim 5 or merely further limits claim 5 by reciting that the coating and image creating units are, for example, "attached" thereby being a "single combined unit". Note the comments above regarding the 35 U.S.C. 112, first paragraph, rejection.

In claim 9 it is not clear how the recitation "adapted to operate" along the entire width of the printing form cylinder limits the scope of the claim. How does this recitation differ from the last two lines of claim 5?

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The claims currently avoid the prior art of record. The total recited combination including, in particular, an imaging unit having the four recited units located below each other and traversing along a form cylinder width could not be found in, nor properly rendered obvious by, the prior art of record. Gelbart ('325) and ('287) teach units mounted beside each other and Love ('340) does not teach a single imaging unit, comprising the four recited units, that traverses the width of the form cylinder.

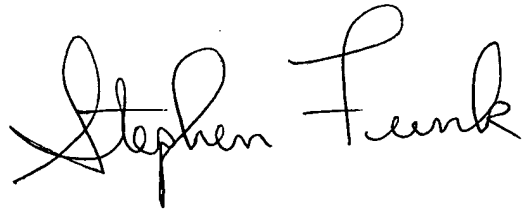
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk
June 18, 2003

A handwritten signature in cursive script that reads "Stephen Funk". The signature is written in black ink and is positioned above the printed name and title.

**STEPHEN R. FUNK
PRIMARY EXAMINER**